

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-46 are pending in this application. Claims 1-7, 16-19, 22-30, 39-42, 45, and 46 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. patent 6,055,573 to Gardenswartz et al. (herein "Gardenswartz") in view of U.S. patent 6,092,053 to Boesch et al. (herein "Boesch"). Claims 8-15, 20-21, 31-38, and 43-44 were rejected under 35 U.S.C. §103(a) as unpatentable over Gardenswartz in view of Boesch and further in view of Official Notice. Those rejections are traversed by the present response as discussed next.

Initially, applicant traverses the basis for the Official Notice in the Office Action and require that prior art be cited for those positions. As discussed in further detail below, applicant also respectfully submits the Official Notice is improper as it suggests modifications to the art contrary to the disclosure in the primary references to Gardenswartz in view of Boesch.

The present invention relates to the use of information obtained from an off-line transaction for use of an analysis of characteristics of a purchaser when considering whether or not to grant authorization for a subsequent on-line transaction. Present specification at page 1, lines 8-11).

The present inventor recognized that in electronic billing systems a person must often enter their billing and personal information at least once, and that it may be preferable if the user did not have to go through the tedious task of himself or herself entering all of their billing information. (Present specification at page 1, lines 18-28.)

The present invention overcomes such deficiencies of known billing systems as, in the present invention, at least some information of or about the user obtained from an off-line transaction is utilized for an on-line transaction. (Specification at page 2, lines 2-5.)

According to a method and system for communicating according to the present invention, a customer's financial information is stored in a supplier computer system based on an off-line transaction between a customer and the supplier. (See for example the present specification at Figure 5, step S402, the present specification at page 10, line 22 to page 11, line 5, the supplier computer system 200 and the databases 224, 226, 228.) An on-line purchase by a customer is begun with the supplier, and information of that beginning is communicated to a server computer by the customer. (See step 450 and Figure 6A and 6D in the present specification, server computer 204, and the present specification at page 12, line 15 et seq.)

The method and system can then determine that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system 200, and which is based on the off-line transaction. (See for example step S404 in Figure 4 in the present specification, and the specification at page 11, line 6 et seq., and the supplier computer system 200.)

Further, information can then be communicated to the customer that the on-line purchase has been approved, after the determining determines that the customer is an acceptable risk. (See for example the present specification at page 14, line 13 et seq., Figure 9, and the display screen 650 which operates as part of a communication.)

As more specific features in the present invention the customer's financial information can be based on a lease, which can be a lease of an image forming device, copier, and facsimile. (See for example Figure 4 in the present specification and the specification at page 8, line 2 to page 9, line 21.)

The above-noted rejections rely on Gardenswartz as the primary reference and then further cite Boesch and Official Notice. The outstanding rejections recognize that Gardenswartz "discloses a method, system and computer program product for delivering a

targeted advertisement based on a customer's off-line purchase history".¹ In that respect applicant notes Gardenswartz is directed to subject matter not at all even related to the claimed invention.

As noted above, the system and method of the present invention determine whether a customer is an acceptable credit risk for an on-line purchase using the customer's financial information based on a prior off-line transaction. Such a system as claimed is thereby directed to a type of "credit exposure management", which allows a supplier to determine a credit risk of customers for sales. Gardenswartz is not directed to any type of similar system. Instead, Gardenswartz is directed to delivering a targeting advertisement based on a customer database. Gardenswartz merely utilizes a server that can provide a targeted price offer advertisement to a customer, but Gardenswartz does not disclose or suggest any determination of whether the customer is an acceptable credit risk for an on-line purchase, based on a prior off-line transaction.

Independent claim 1 specifically recites an operation of "determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction". Independent claim 42 recites a similar feature. That feature is believed to clearly distinguish over Gardenswartz which was cited as meeting that claimed feature.

In further detail, with respect to the above-noted feature the outstanding rejection cites Gardenswartz at "figure 8/element 70, col. 12, lines 65-67, figure 10/element 1000, col. 15, lines 19-40".² Applicant traverses that grounds for rejection and notes the cited disclosures in Gardenswartz are not at all related to the above-noted claimed feature.

At Figure 8, element 70, and the corresponding description at column 12, lines 65-67 Gardenswartz notes sending purchase history criterion to an analytics unit. However, that

¹ Office Action of June 13, 2007, page 3, prenumbered paragraph 8.

² Office Action of June 13, 2007, page 3, prenumbered paragraph 9, lines 10-11.

operation in Gardenswartz is not directed to determining whether a customer is an acceptable credit risk for an on-line purchase. Instead, that operation in Gardenswartz is directed to determining the targeted ad to send to the customer. That is evident from steps 74-76 in Figure 8 that are all directed to generating a targeted ad based on the purchase history criterion. Thereby, that noted disclosure in Gardenswartz is not at all directed to the claimed features of determining a credit risk of a customer for a subsequent on-line purchase.

Further, at Figure 10, element 1000, and the corresponding disclosure at column 15, lines 19-40 Gardenswartz indicates the analytics unit 16 searches a purchase history database for consumers and then ultimately offers the consumer a new “value contract” in step 1014 based on their purchase history. However, that disclosure in Gardenswartz is also not directed to the claimed features of determining the credit risk of a consumer for an on-line purchase subsequent to an off-line transaction. In that respect applicant also notes the outstanding grounds for rejection appears to be completely misconstruing what a “value contract” is in Gardenswartz. Gardenswartz specifically states:

The value contract offers the consumer a reward for complying with a given type of behavior. This behavior may be a predefined change in behavior or continuance of an established behavior. Preferably, the behavior is defined as a minimum number of purchases that must be made within a predetermined time period...Once a consumer wins a reward, the reward is preferably presented to the consumer in a retail store. Thus, the reward provides an incentive for the consumer to visit the retail store.³

Thereby, in Gardenswartz the “value contract” is nothing more than an in store promotion for a consumer. Such a disclosure in Gardenswartz is in fact also merely directed to providing a consumer with a targeted advertisement or “value contract” based on their purchase history. That disclosure in Gardenswartz is not at all directed to determining the credit risk of the consumer for an on-line transaction based on and subsequent to an off-line

³ Gardenswartz at column 3, line 61 to column 4, line 12.

transaction. Applicant also point out the “value contract” in Gardenswartz is directed to an opposite objective as in the claimed invention. The “value contract” in Gardenswartz is directed to providing a consumer with a reward as an incentive for the consumer to visit a retail store. The claims are clearly directed to an “on-line transaction”, not an in-store transaction, subsequent to an off-line transaction. Thereby, Gardenswartz in fact teaches away from the above-noted claimed feature.

In such ways, applicant respectfully submits the outstanding rejection is misconstruing the teachings in Gardenswartz as Gardenswartz does not in fact disclose or suggest “determining whether the customer is an acceptable credit risk for the on-line purchase using the customer’s financial information in the supplier computer system and which is based on the off-line transaction”, as recited in the claims.

Moreover, no teachings in Boesch are believed to cure the above-noted deficiencies in Gardenswartz. In that respect applicant also reiterates that Gardenswartz is directed to a contrary objective as in the claimed invention and thus could not have been modified by Boesch to meet the above-noted claimed features.

Applicant also submits the outstanding rejection is misconstruing several features in the dependent claims relative to the applied art.

With respect to dependent claims 2 and 25, the outstanding rejection also cites the disclosure in Gardenswartz to the “value contract”.⁴ As discussed above the “value contract” in Gardenswartz is not at all directed to an off-line transaction such as a lease.

With respect to claims 3-5 and 26-28, the outstanding rejection appears to indicate Gardenswartz could include the features recited therein. However, again applicant notes Gardenswartz is not directed to the claimed features of utilizing a specific type of off-line

⁴ Office Action of June 13, 2007, page 4, prenumbered paragraph 12.

transaction to determine a customer's credit risk for a subsequent on-line purchase. Thereby, Gardenswartz in fact teaches away from the features in dependent claims 3-5 and 26-28.

With respect to claims 6-7 and 29-30, as discussed above in detail, Gardenswartz teaches away from the features therein.

Again with respect to dependent claims 8-15, 20-21, 31-38, and 43-44, applicant traverses the basis for the Official Notice and require that prior art be cited for the features recited therein. In that respect applicant reiterates Gardenswartz teaches away from the claimed features, and thus applicant request clear motivation be set forth to modify Gardenswartz to meet such further claim features in view of the new art to be cited for the propositions for which Official Notice was taken.

In view of the foregoing comments, applicant respectfully submits the claims as currently written distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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